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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,565	07/02/2003	Jack R. Barber	016556-003010US	5484
20350	7590	07/28/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			GIBBS, TERRA C	
		ART UNIT	PAPER NUMBER	
		1635		

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*KC*

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/613,565	BARBER ET AL.
	Examiner	Art Unit
	Terra C. Gibbs	1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 May 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 39-98 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 39-41, 64, 65, 69-71, 94, and 95 is/are rejected.

7) Claim(s) 42-63, 66-68, 72-93 and 96-98 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

This Office Action is a response to Applicants Amendment and Remarks filed May 13, 2005.

Claims 39-98 are pending in the instant application.

It is acknowledged that claims 69-98 correspond exactly or substantially to one or more claims of U.S. Patent 6,448,009. Additionally, it is acknowledged that claims 39-68 correspond exactly or substantially to one or more claims of U.S. Patent 6,183,959.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Nucleotide and/or Amino Acid Sequence Disclosure***

In the previous Office Action mailed January 19, 2005, the Examiner pointed out that this application fails to comply with the requirements of 37 §1.821 through 1.825 for the reason(s) set forth below. Applicants amendment filed May 13, 2005 to insert sequence identifiers into the instant specification is acknowledged.

***Double Patenting***

In the previous Office Action mailed January 19, 2005, claims 39-98 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,605,429 ('429). **This rejection**

is withdrawn in view of Applicants submission of the terminal disclaimer filed May 13, 2005.

After careful reconsideration of the claims, the following new rejection is made of record:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-41, 64, 65, 69-71, 94, and 95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claims 64, 65, 94, and 95 recite the limitations, "wherein said substrate binding domain is of length between 12 and 100 nucleotides" and "wherein said substrate binding domain is of length between 14 and 24 nucleotides". In the amendment filed September 8, 2003, Applicants contend that support for claims 94 and 95 can be found in the instant specification at page 22, second ¶. In the amendment filed July 2, 2003, Applicants contend that claims 64 and 65 were copied from the amendment of February

5, 2002, in the prior application 09/355,221, which were copied from U.S. Patent No. 6,183,959. Referring to the amendment of February 5, 2002, in the prior application 09/355,221, Applicants contend that support for claims 64 and 65 can be found on page 22, second ¶. Referring to page 22 second ¶ in the instant application and in prior application 09/355,221, the Examiner cannot find support for the ranges "between 12 and 100 nucleotides" and "between 14 and 24 nucleotides" as recited in claims 64, 65, 94, and 95.

In summary, it does not appear that Applicants have support for the limitations, "wherein said substrate binding domain is of length between 12 and 100 nucleotides" and "wherein said substrate binding domain is of length between 14 and 24 nucleotides" as recited in claims 64, 65, 94, and 95. Therefore, claims 64, 65, 94, 95 and claims that depend therein appear to contain new matter.

Applicant is required to cancel the new matter or specifically point out the support for the limitations, wherein said substrate binding domain is of length between 12 and 100 nucleotides" and "wherein said substrate binding domain is of length between 14 and 24 nucleotides" in the reply to this Office Action.

### ***Conclusion***

Claims 42-63,66-68, 72-93, and 96-98 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, claims 43-

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63,66-68 correspond exactly or substantially to one or more claims of U.S. Patent 6,183,959. Additionally, claims 72-93, and 96-98 correspond exactly or substantially to one or more claims of U.S. Patent 6,448,009. In this regard, the instant application would be interfering with the issued U.S. Patents, if not for the outstanding 35 U.S.C. 112, first paragraph rejection against claims 39-41, 64, 65, 69-71, 94, and 95 for new matter as detailed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terra C. Gibbs whose telephone number is 571-272-0758. The examiner can normally be reached on 9 am - 5 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tcg  
July 22, 2005



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